



UNITED STATES PATENT AND TRADEMARK OFFICE

ch
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,691	05/08/2005	Jill Van Winkle	AG03-005C-US	3095

7590 11/28/2006
Anne Carlson, Ph.D.
Klarquist Sparkman, LLP
One World Trade Center, Suite 16
121 S.W. Salmon Street
Portland, OR 97204-2988

EXAMINER

KUMAR, VINOD

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/509,691	Applicant(s) VAN WINKLE ET AL.	
	Examiner Vinod Kumar	Art Unit 1638	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-11 are examined in this Office action. All previous rejections not set forth below have been withdrawn. This action is made FINAL.

Claim Rejections - 35 USC § 102

2. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Alexandrov et al. (EP1033405, Published June 9, 2000) for the reasons of record stated in Office actions mailed on June 14, 2006. Applicants traverse the rejection in the paper filed on September 14, 2006.

Applicants argue that Applicants were not able to examine the SEQ ID NO: 33003 disclosed in Alexandrov et al., or compare that sequence to SEQ ID NO: 2. Applicants request a sequence alignment of SEQ ID NO: 33003 and instant SEQ ID NO: 2 (response, page 9, lines 8-11).

Applicants are reminded that a complete copy of Alexandrov et al. reference was mailed along with the Office action mailed on June 14, 2006. Besides, results of sequence search are available to Applicants through PAIR system, see <http://pair-direct.uspto.gov>. An additional copy of sequence alignment of SEQ ID NO: 33003 and instant SEQ ID NO: 2 is also being made available to the Applicant along with the instant Office action.

Applicants argue that claims 1-11 are not anticipated by Alexandrov et al. because the reference does not include enabling disclosure. Applicants further argue that reference does not teach or suggest that SEQ ID NO: 33003 can be used to impart drought tolerance to a given plant, and one of ordinary skill in the art would not know to select SEQ ID NO: 33003 over the other thousands of sequences disclosed to generate this feature without undue experimentation (response, page 9, lines 23-31). Applicants further argue that if anticipation is based upon the inherent teaching of a prior art reference, Office must provide a rationale or evidence tending to show inherency. The reference does not demonstrate the capabilities of any of the disclosed sequence including SEQ ID NO: 33003 to impart drought tolerance and a person of ordinary skill would not recognize drought tolerance property of SEQ ID NO: 33003 based on the teachings of the reference (response, page 9, lines 9-11, lines 18-25).

Applicant's arguments were fully considered but were not found persuasive. Office maintains that pages 341; 343; claims 1, 25, 29-34; page 326, paragraph 2279; page 327; page 329, paragraphs 2301-2308 of the reference clearly disclose a method of making a transgenic plant comprising introducing and expressing a polynucleotide sequence encoding SEQ ID NO: 33003 which has 100% sequence identity to instant SEQ ID NO: 2. Office further maintains that the property of drought tolerance of transgenic plant expressing said polynucleotide sequence is inherent to the sequence disclosed in the reference. This is also evidenced by Harper et al. (cited in the summary of Office action mailed on June 14, 2006) who disclose a stress (includes drought) tolerant transgenic plant and a method of making said transgenic plant comprising introducing and expressing a polynucleotide sequence of SEQ ID NO: 1986

Art Unit: 1638

which has 100% sequence identity to instant SEQ ID NO: 1 which encodes instant SEQ ID NO: 2. Applicants are also reminded that when the reference relied on expressly anticipates all of the elements of the claimed invention, the reference is presumed to be operable or enabling. See *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07.

Furthermore, Alexandrov et al. method steps of making a transgenic plant using a polynucleotide encoding SEQ ID NO: 33003 are identical to the instant method steps of instantly claimed method of making a transgenic plant using SEQ ID NO: 1. If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, rather than any distinct definition of any of the claimed invention's limitations, then preamble is not considered a limitation and is of no significance to claim construction. See MPEP 2111.02. Also see *In re Cruciferous Sprout Litig.*, 301 F.3d 1343, 1346-48, 64 USPQ2d 1202, 1204-05 (Fed. Cir. 2002) where a claim at issue was directed to a method of preparing a food rich in glucosinolates wherein cruciferous sprouts are harvested prior to the 2-leaf stage. The court held that the preamble phrase "rich in glucosinolates" helps define the claimed invention, as evidenced by the specification and prosecution history, and thus is a limitation of the claim (although the claim was anticipated by prior art that produced sprouts inherently "rich in glucosinolates"). Furthermore, see *Integra LifeSciences I Ltd. V. Merck KGaA* 50 USPQ2d 1846, 1850 (DC Scalif 1999), which teaches that where the prior art teaches all of the required steps to practice the claimed method and no additional manipulation is required to produce the claimed result, then prior art anticipates the claimed invention.

Art Unit: 1638

Accordingly, the rejection is maintained.

Summary

3. No claims are allowed.

Applicants amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is set to expire within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Contact Information

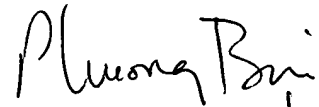
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinod Kumar whose telephone number is (571) 272-4445. The examiner can normally be reached on 8.30 a.m. to 5.00 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anne Marie Grunberg can be reached on (571) 272-0975. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number: 10/509,691

Page 6

Art Unit: 1638

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



PHUONG T. BUI
PRIMARY EXAMINER

10/19/06